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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,715	11/21/2003	Joseph H. Schulman	A328A-USA	3163

24677 7590 10/06/2005

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EXAMINER	
LACYK, JOHN P	

ART UNIT	PAPER NUMBER
3735	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/719,715	SCHULMAN ET AL.	
	Examiner	Art Unit	
	John P. Lacyk	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-52 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-52 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 11/21/03,3/31/04;.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,185,452. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are an obvious change or rearrangement in the scope of the invention. It is clear that the claims recite a system for stimulating tissue having a sealed housing having the same dimensions, configured for implantation containing a power consuming circuitry including a battery, electrode, capacitor, coils, and means for energizing the coils. Since the claims are merely a rearrangement in the scope of the claims and are not patentably distinct from one another the obviousness-type double patenting rejection applies. Also with respect to claims 3, 5,7, 15 to choose any desired shape of the container is considered to have been an obvious engineering design choice without a showing of criticality.

3. Claims 1-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,164,284. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are an obvious change or rearrangement in the scope of the invention. It is clear that the claims recite a system for stimulating tissue having a sealed housing having the same dimensions, configured for implantation containing a power consuming circuitry including a battery, electrode, capacitor, coils, and means for energizing the coils. Since the claims are merely a rearrangement in the scope of the claims and are not patentably distinct from one another the obviousness-type double patenting rejection applies. Also to choose any desired shape of the container is considered to have been an obvious engineering design choice without a showing of criticality.

4. Claims 1-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,564,807. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are an obvious change or rearrangement in the scope of the invention. It is clear that the claims recite a system for stimulating tissue having a sealed housing having the same dimensions, configured for implantation containing a power consuming circuitry including a battery, electrode, capacitor, coils, and means for energizing the coils. Since the claims are merely a rearrangement in the scope of the claims and are not patentably distinct from one

another the obviousness-type double patenting rejection applies. Also with to choose any desired shape of the container is considered to have been an obvious engineering design choice without a showing of criticality.

5. Claims 1-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,315,721. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are an obvious change or rearrangement in the scope of the invention. It is clear that the claims recite a system for stimulating tissue having a sealed housing having the same dimensions, configured for implantation containing a power consuming circuitry including a battery, electrode, capacitor, coils, and means for energizing the coils. Since the claims are merely a rearrangement in the scope of the claims and are not patentably distinct from one another the obviousness-type double patenting rejection applies. Also with to choose any desired shape of the container is considered to have been an obvious engineering design choice without a showing of criticality.

6. Claims 1-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,208,894. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are an obvious change or rearrangement in the scope of the invention. It is clear that the claims recite a system

for stimulating tissue having a sealed housing having the same dimensions, configured for implantation containing a power consuming circuitry including a battery, electrode, capacitor, coils, and means for energizing the coils. Since the claims are merely a rearrangement in the scope of the claims and are not patentably distinct from one another the obviousness-type double patenting rejection applies. Also with to choose any desired shape of the container is considered to have been an obvious engineering design choice without a showing of criticality.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

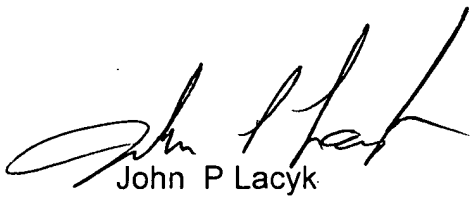
8. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujii et al.

Fujii et al teaches a device having an elongate housing (Figures 2, 4 and 6) configured for implantation having controlling circuitry having a battery (124), electrode (125), and transmitting and receiving portions, which are well known to use coils and means for energizing the external coil to supply energy to the internal coil (159).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Lacyk whose telephone number is 571-272-4728. The examiner can normally be reached on Mon-Fri, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P Lacyk
Primary Examiner
Art Unit 3736

J.P. Lacyk